



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/668,158	09/24/2003	Seiji Horie	019519-407	2772

21839 7590 07/10/2006

BUCHANAN INGERSOLL PC
POST OFFICE BOX 1404
ALEXANDRIA, VA 22313-1404

EXAMINER

SHOSHO, CALLIE E

ART UNIT	PAPER NUMBER
----------	--------------

1714

DATE MAILED: 07/10/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action Before the Filing of an Appeal Brief	Application No. 10/668,158	Applicant(s) HORIE ET AL.	
	Examiner Callie E. Shosho	Art Unit 1714	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 26 June 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☒ Applicant's reply has overcome the following rejection(s): see attachment.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____
Claim(s) objected to: 5.
Claim(s) rejected: 1,2,4 and 7.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☐ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____
13. ☐ Other: _____.

Callie E. Shosho
Primary Examiner
Art Unit: 1714

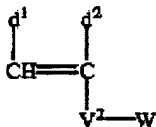
DETAILED ACTION

1. Applicants' amendment filed 6/26/06 overcomes the 35 USC 112, first paragraph rejection of record set forth in paragraph 3 of the office action mailed 3/24/06 as well as the 35 USC 102 rejections of record set forth in paragraphs 5 and 7 of the office action mailed 3/24/06 utilizing Suzuki et al. (U.S. 5,254,425) and Qian et al. (U.S. 2002/0128349).

However, the amendment does not overcome the 35 USC 102 rejection of record set forth in paragraph 6 or the 35 USC 103 rejection of record set forth in paragraph 9 of the office action mailed 3/24/06 which each utilize Kato (U.S. 6,302,537).

With respect to Kato, applicants argue that there is no disclosure in Kato of block copolymer having repeating unit (a) corresponding to a monofunctional monomer containing an aliphatic cyclic hydrocarbon group having from 5 to 30 carbon atoms as now required in all the present claims.

However, it is noted that Kato discloses oil-based ink comprising copolymer resin particles obtained by polymerization of solution containing monofunctional monomer (A), monofunctional monomer (B) having amino group, and resin for dispersion stabilization (P) comprising component represented by formula (II) (col.3, line 29-col.4, line 15). It is further disclosed that the resin for dispersion stabilization (P) is a block copolymer obtained from component represented by formula (II) and component corresponding to other copolymerizable monomer including component corresponding to monomer (A) (col.12, line 66-col.13, line 7) wherein monomer (A) is of the formula:



which is identical to presently claimed formula (I) when V² is -COO-, -OCO-, etc., W is cyclopentyl, and d¹ and d² are each hydrogen, halogen, cyano group, etc. (col.7, line 63-col.8, line 39).

In light of the above, it is the examiner's position that Kato do disclose block copolymer as presently claimed.

Applicants also argue that there is no disclosure in Grobe et al. (U.S. 6,465,567) of block copolymer.

However, it is noted that Grobe et al. is not used for its teaching of block copolymer. This is already taught by Kato. Rather, Grobe et al. is used to teach the surface tension of inks used in conventional ink jet printers. While there is no disclosure in Grobe et al. of block copolymer as presently claimed, Grobe et al. is used as teaching reference, and therefore, it is not necessary for this secondary reference to contain all the features of the presently claimed invention, *In re Nievelt*, 482 F.2d 965, 179 USPQ 224, 226 (CCPA 1973), *In re Keller* 624 F.2d 413, 208 USPQ 871, 881 (CCPA 1981). Rather this reference teaches a certain concept, namely, surface tension of ink jet inks, and in combination with the primary reference, discloses the presently claimed invention.

Art Unit: 1714

It is noted that in light of applicants' amendment, claim 5 is now objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claim 5 would be allowable if rewritten in independent form as described above given that there is no disclosure in the "closest" prior art Suzuki et al. (U.S. 5,254,425), Qian et al. (U.S. 2002/0128349), or Kato (U.S. 6,302,537) of method of forming an image by an inkjet recording system using an oil based ink composition comprising discharging the oil based ink from inkjet recording device wherein the oil based ink comprises fine particle dispersed in a nonaqueous dispersion medium wherein each fine particle comprises coloring agent and binder resin that is block copolymer having a repeating unit corresponding to a monofunctional monomer containing an aliphatic cyclic hydrocarbon group having 5 to 30 carbon atoms and wherein the ink further comprises a dispersant for pigment as required in present claim 5.



Callie E. Shosho
Primary Examiner
Art Unit 1714

CS
7/5/06